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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/708,931	11/08/2000	Nathan B. Emery	5121	2998

7590 02/17/2004

Millen & Company  
P O Box 1927  
Spartanburg, SC 29304

EXAMINER

BEFUMO, JENNA LEIGH

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 02/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/708,931

Applicant(s)

EMERY ET AL.

Examiner

Jenna-Leigh Befumo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 8-15 and 34-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 16-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. The pending claims are 1 – 36. Claims 8 – 15 and 34 – 36 are withdrawn from consideration as being drawn to a nonelected invention.
2. The 35 USC 112 2<sup>nd</sup> paragraph rejection to the term “broken-filament yarns” is withdrawn since the Applicant has defined the term in the disclosure by stating that “broken-filament yarns are processed such that some of loop formed in air jet texturing are broken”.

### ***Claim Rejections - 35 USC § 102***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 16, 29, 30, 31, 32, and 33 stand rejected under 35 U.S.C. 102(b) as being anticipated by Merriman (1,987,858) for the reasons of record.

### ***Claim Rejections - 35 USC § 102/103***

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claims 1 – 7 and 17 – 28 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Merriman for the reasons of record.

### ***Claim Rejections - 35 USC § 103***

7. Claims 1 – 7 and 16 – 33 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Collier (5,487,936) for the reasons of record.

### ***Response to Arguments***

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8. Applicant's arguments filed November 19, 2003 have been fully considered but they are not persuasive. First, the Applicant argues that the limitations in claim 16, which states "the surface hand of the face of the fabric is approximately equal to the surface hand of the back of the fabric," is not taught by Merriman since Merriman does not disclose napping both sides of the fabric. However, the applicant never requires that the hand is measured in the areas which are napped. Merriman teaches that the surface of the fancy weave fabric is napped which produces unnapped and napped regions. The hand of the unnapped regions would be approximately equal to the hand of the back of the fabric which has not been napped. Therefore, the limitation is met by the teaching of Merriman.

With respect to the Applicant's arguments that the limitations that the fabric is napery or curtains distinguishes the claimed fabric over the prior art, it is again set forth that those limitations are interpreted as intended use and are not given any patentable weight since they fail to add any further structural limitations to the fabric. It has been held that a recitation with respect to the manner in which a claimed product is intended to be employed does not differentiate the claimed product from a prior art product satisfying the claimed structural limitation. *Ex parte Masham*, 2 USPQ2d 1647 (1987). In this case, the fact that a fabric is put on a table or hung from a curtain rod, does not in any way change the structure of the fabric itself, it only changes where the fabric is or how the fabric is used which are not given patentable weight. If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose of intended use of the invention, rather than any distinct definitions, then the preamble is not considered a limitations and is of no significance to claim construction. *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182

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F.3d 1298, 1305, 51 USPQ 2d 1161, 1165 (Fed. Cir. 1999). Additionally, it has been held that if a prior art structure is capable of performing the intended use as recited in the preamble, then it meets the claim. In *re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). In other words, the Applicant cannot overcome an anticipation rejection because the Applicant's product has a different use than the prior art, since the prior art is capable of performing the intended use. Thus, the rejection is maintained.

Further, the Applicant argues that Merriman discloses a conventional napping process and does not teach napping both surfaces, and thus would not have the claimed properties. First, it is noted that the Applicant fails to claim a specific napping process, nor has the Applicant provided any evidence that proves that a specific napping process would produce a structurally different product. Thus, the manner in which the fabric is napped is not given any patentable weight. Therefore, it only matters if the fabric is napped, not how the fabric is napped. Second the Applicant does not claim that the fabric must be napped on both sides. Therefore, the prior art does not need to teach a fabric which is napped on both side.

With respect to the claimed properties, as set forth in the previous Office action, the properties are presumed to be inherent to the fabric, since the prior art teaches all the structural limitations recited in the claims. When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not. In *re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Thus, the burden has shifted to the Applicant to provide evidence that the properties are not inherent in the prior art materials. In *re Best*, 562 F.2d at 1255, 195 USPQ at 433. Arguments of

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counsel cannot take the place of evidence. *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984). Therefore, the rejections are maintained.

With respect to Collier, the Applicant argues that Collier teaches conventional napping process and thus napping the fabric on both side would not produce an approximately equal surface on both sides of the fabric. Again it is noted that the Applicant does not claim a specific type of napping, nor has the Applicant shown that a specific type of napping is required to produce the claimed properties. Further, with respect to a disclosure to produce the same surface roughness on both sides of the fabric, the rejection was made with an obviousness statement that provided reasons why one of ordinary skill in the art would treat both sides of the fabric. The Applicant has provided no arguments that the obviousness statement was flawed, and thus is maintained. Further, it is again noted that the arguments of counsel cannot take the place of evidence and the Applicant must provide evidence to prove that the claimed properties would not be present in the prior art fabric.

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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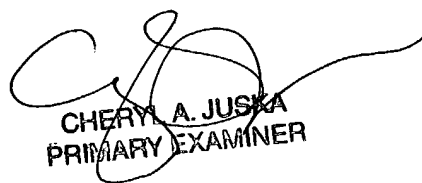
however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenna-Leigh Befumo whose telephone number is (571) 272-1472. The examiner can normally be reached on Monday - Friday (8:00 - 5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jenna-Leigh Befumo  
February 4, 2004



CHERYL A. JUSKA  
PRIMARY EXAMINER